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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/711,261	11/10/2000	John DeMayo	2580-019	6688
22852	7590	03/22/2005	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			CHAMPAGNE, DONALD	
		ART UNIT	PAPER NUMBER	
		3622		

DATE MAILED: 03/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<i>V</i> <b>Office Action Summary</b>	Application No.	Applicant(s)
	09/711,261	DEMAYO ET AL.
	Examiner	Art Unit
	Donald L. Champagne	3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 27 January 2005.
- 2a) This action is FINAL.                  2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-32 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 10 November 2000 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)                  4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.  
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)                  5) Notice of Informal Patent Application (PTO-152)  
3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.                  6) Other:

## DETAILED ACTION

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 27 January 2005 has been entered.

### ***Response to Arguments***

2. Applicant's arguments filed with an amendment on 27 January 2005 have been fully considered, as have the arguments made by applicant's representative in an interview of 22 February 2005, but they are not persuasive. The arguments have been considered in the following non-final rejection, and are discussed explicitly at para. 9-13 below.

### ***Claim Rejections - 35 USC § 102 and 35 USC § 103***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3622

5. Claims 1-2, 4-6, 9-10, 12-13, 21, 24 and 31 are rejected under 35 U.S.C. 102(e) as being as anticipated by Bull et al.
6. Bull et al. teaches (independent claims 1, 9, 21 and 24) an apparatus and method for hyperlinking specific words in content or in text-containing files, or displayed in an application, to convert the words into advertisements, the method comprising: connecting a content provider server to the Internet, said content provider having content files to be displayed (col. 3 lines 31-34 and 66-67); providing an advertiser web page so as to be accessible over the Internet (col. 5 lines 11-12); and connecting an ad server (*advertiser's computer system 400*, col. 8 line 10 and Fig. 1) to the Internet, wherein the ad server provides a *hot link* (col. 8 line 20), which reads on a hypertext link or hyperlink (Microsoft Press Computer Dictionary), to a word or phrase (e.g., *Inns on the West Coast*, col. 15 lines 39-42) in a content file to link an Internet-enabled web browsing device connected to the Internet to said advertiser web page (col. 15 lines 24-25).
7. Bull et al. also teaches that said word or phrase is advertiser-chosen. The reference teaches that the advertiser chooses the criteria by which the ads are placed (col. 8 lines 3-5 and 19-22), said advertiser-chosen criteria being used to choose said word or phrase (col. 5 lines 14-25).
8. Bull et al. does not explicitly teach a hypertext anchor to said advertiser-chosen word or phrase. However, under the principles of inherency (MPEP § 2112.02), since the reference invention necessarily performs the method claimed, the method claimed is considered to be anticipated by the reference invention. As evidence tending to show inherency, the reference teaches ads hyperlinked (col. 4 lines 29-30 and col. 8 lines 19-21) to pages based on keywords in the content of that page (col. 5 lines 11-12 and 19-20). If a hyperlink is executed from text, there must be a hyperlink anchor at said text (Microsoft Press Computer Dictionary definition 2 of "anchor"). Since the hyperlink is executed by the appearance of the keyword(s) or advertiser-chosen word or phrase, the anchor is, by definition, at said advertiser-chosen word or phrase.
9. Applicant argues (p. 12 *et seq.*) that Bull et al. does not teach providing a hypertext anchor to an advertiser-chosen word or phrase in some content so as to link said word or phrase to an advertiser web page. Rather, applicant argues, Bull et al. teaches inserting ads in said content, not providing said ads by hypertext link to an advertiser web page.

Art Unit: 3622

10. Applicant's argument is not accepted because it is a narrow reading of some parts of Bull et al. without regard to other parts that shed light on the reference's teachings. The test for patentability is the preponderance of all the evidence (MPEP §706.1.), not solely the evidence favored by applicant.
11. It is true that Bull et al. does literally teach "The ad will be inserted based on the content of the existing web page being read" (col. 5 lines 19-20 or col. 15 lines 24-25). The reference appears to reinforce this "ad insertion" teaching by repeating it at col. 9 lines 37-39 and col. 15 lines 26-28 and line 41. Furthermore, the reference discusses an ad insertion agent and system at col. 12 lines 12-16 and col. 13 lines 54-58.
12. However, Bull et al. teaches hypertext links and their importance on the Web at col. 1 lines 30-32, col. 3 lines 51-55 and 56-58, col. 4 lines 26-31, col. 7 lines 34-44 and the aforementioned col. 8 line 19-21. Especially important are the following teachings.

"On the World Wide Web (WWW), a technology called hypertext allows Internet addressable resources to be connected, or linked, to one another." (Col. 1 lines 30-32.)

"Selected text can be 'expanded' at any time to provide other information. These words are, thus, linked to other documents." (Col. 3 lines 56-58.)

**"Along with displays, including those for data entry, searches, search results, information retrieval, the user will be presented with advertisements and/or coupons based on criteria entered by advertisers. This criteria may take the form of simple logic, linking an ad/coupon with a display ..."** (Col. 4 lines 26-31, emphasis added.)

13. In sum, the reference appears to teach that ads may be presented either by literal insertion or by hyperlink. Since a reference is available for all that it teaches, Bull et al. does teach providing a hypertext anchor to an advertiser-chosen word or phrase in some content so as to link said word or phrase to an advertiser web page.
14. Bull et al. does not explicitly teach (independent claim 31) displaying a description of the advertiser web page when a mouse pointer is positioned over the hyperlink. However, under the principles of inherency (MPEP § 2112.02), since the reference invention necessarily performs the method claimed, the method claimed is considered to be anticipated by the reference invention. As evidence tending to show inherency, the reference teaches clicking on a URL (col. 14 lines 50-52), in order to access a Web page.

Art Unit: 3622

The mouse pointer must inherently be positioned over the URL link in order to activate said link by clicking on it.

15. Bull et al. also teaches at the citations given above claims 2, 4-6, 10, 12 and 13.
16. Claims 3, 7, 11, 14-15, 22 and 25 are rejected under 35 U.S.C. 103(a) as being obvious over Bull et al. Bull et al. does not teach (claims 3, 11, 22 and 25) using a script to provide a hypertext anchor and (claims 7 and 14-15) using frames to display the content provider URL in a browser window. It was common, at the time of the instant invention, to use script to provide a hypertext anchor and display the URL of content in a browser window using frames. Because it is efficient to use common and well known practices, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of Bull et al. the use of script to provide a hypertext anchor and the use of frames to display the content provider URL in a browser window.
17. Official notice of this common knowledge or well known in the art statement was taken in the last Office action (mailed 2 August 2004, para. 11). This statement is taken to be admitted prior art because applicant either failed to traverse the examiner's assertion of official notice or that the traverse was inadequate. (MPEP 2144.03.C.).
18. Claims 8, 16, 23 and 26 are rejected under 35 U.S.C. 103(a) as being obvious over Bull et al. in view of Kirsch et al. (US006189030B1). Bull et al. does not teach linking to said advertiser web page using a tracking URL. Kirsch et al. teaches linking to said advertiser web page (*the external server system*, col. 7 lines 10-17) using a tracking server system (col. 5 lines 14-26), which reads on a tracking URL. Because Kirsch et al. teaches that tracking clicks is important (col. 2 lines 34-38 and col. 6 lines 60-61) and that the reference invention does so expediently, with minimum latency and visibility (col. 5 lines 33-37), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add Kirsch et al. to the teachings of Bull et al.
19. Claims 17-19, 27-29 and 31 are rejected under 35 U.S.C. 103(a) as being obvious over Bull et al. in view of Murray.
20. Bull et al. does not teach (independent claims 17 and 27) the advertiser compensating at least one of a content provider and an entity that selects said hypertext anchor. Murray teaches the advertiser compensating at least one of a content provider and an entity that

Art Unit: 3622

selects said hypertext anchor (col. 8 lines 19-20). Because it facilitates the acceptance of advertising (col. 2 lines 22-24), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add Murray to the teachings of Bull et al.

21. Murray also teaches claims 18 and 28 at the citation given above.
22. Claims 19, 20, 29, 30 and 32 are rejected under 35 U.S.C. 103(a) as being obvious over Bull et al. in view of Murray and further in view of Kirsch et al.
23. Neither Bull et al. nor Murray teaches (claims 20 and 30) linking to said advertiser web page using a tracking URL. Kirsch et al. teaches linking to said advertiser web page (*the external server system*, col. 7 lines 10-17) using a tracking server system (col. 5 lines 14-26), which reads on a tracking URL. Because that tracking clicks is important (col. 2 lines 34-38 and col. 6 lines 60-61) and that the reference invention does so expediently, with minimum latency and visibility (col. 5 lines 33-37), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add Kirsch et al. to the teachings of Bull et al. and Murray.
24. Kirsch et al. also teaches claims 19, 29 and 32 (col. 2 lines 29-38).

### ***Conclusion***

25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 6:30 AM to 5 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at [donald.champagne@uspto.gov](mailto:donald.champagne@uspto.gov), and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.
26. The examiner's supervisor, Eric Stamber can be reached on 703-305-8469.<sup>1</sup> The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.
27. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published

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<sup>1</sup> 571-272-6724 after the middle of April 2005.

applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**28. ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, [www.uspto.gov](http://www.uspto.gov). At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

DONALD L. CHAMPAGNE  
PRIMARY EXAMINER

Donald L. Champagne  
Primary Examiner  
Art Unit 3622

15 March 2005